

**REMARKS**

Claims 28-72 were previously presented for consideration. These claims are fully supported by the original disclosure, including original claims 15 and 18. Accordingly, claims 1-72 are pending in the reissue. Claims 1, 2, 7, 16, 19-21, 23, 28-45, and 52-72 are independent.

The Examiner's indication that claims 1-15, 20, and 23-27 are allowed, is noted with appreciation.

**Claims 28-72**

Claims 28-72 recite additional aspects of coverage to which Applicants are entitled protection. These claims are fully supported by the specification. Additionally, as mentioned previously, the changes recited in these claims eliminate language that could give rise to "means plus function" interpretation.

Applicants therefore respectfully submit that these claims are supported by the specification and in condition for allowance.

**Drawings**

The Office Action objected to the drawings because the PTO no longer transfers drawings from the patent files.

Applicants are submitting a new set of drawings to be included with the current file. Withdrawal of this objection is respectfully requested.

**Missing Papers**

It appears that executed copies of formal documents such as the assignee consent and offer to surrender may have been misplaced and are currently not available in file history.

Applicants are unaware of ever having filed such papers without appropriate signatures. Review of applicants' file has revealed fully executed copies of these documents. Applicants therefore are including fully executed copies of these documents together with the present response.

#### Objection to Reissue Declaration

The Reissue oath/declaration filed with the application was objected to as being defective for failing to identify at least one error which is relied upon to support the Reissue application. The Office Action indicates that the declaration did not sufficiently specify, or give a proper example of the error. Rather, the example set forth in the declaration was indicated as stating only that the error pertains to "omission of broader claims to an operator assisted prescription dispensing system and a method of dispensing pills in a prescription dispensing system." This was not considered an error by the Office Action indicates that the patent inherently applies to the operator assisted system and method as set forth in the original claims.

During a telephone conference on July 27, 2004, the Examiner agreed to reconsider Applicants' arguments description of the errors that are relied upon. Applicants further indicated to the Examiner that the pending reissue declaration specifically identifies at least two errors (i.e., "omission of broader claims to an operator assisted prescription dispensing system and a method of dispensing pills in a prescription dispensing system."), despite the fact that the M.P.E.P. only requires identification of only one error.

Applicants therefore urge the Examiner to favorably reconsider the oath/declaration and conclude that it is not defective and does not require any changes.

Prior Art Rejections

Claims 16 and 46 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,208,762 issued to Charhut. Claims 21 and 52 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,953,745 issued to Rowlett. Claims 28-45, 54, and 55 were rejected under 35 U.S.C. §102(b) as being anticipated by either U.S. Patent No. 4,664,289 issued to Shimizu, Rowlett, or Charhut. Claims 49-51 were rejected under 35 U.S.C. §102(b) as being anticipated by Charhut. Claims 17 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Charhut in view of U.S. Patent No. 3,139,713 issued to Merrill. Claim 18 was rejected under 35 U.S.C. §103(a) as being unpatentable over Charhut. Claims 16, 18, and 46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shimizu in view of Charhut. Claim 17 was rejected under 35 U.S.C. §103(a) as being unpatentable over Shimizu in view of Charhut and further in view of Merrill. Claims 16-18 and 46 were rejected under 35 U.S.C. §103(a) as being unpatentable over admitted prior art in view of Charhut. Claim 19 was rejected under 35 U.S.C. §103(a) as being unpatentable over admitted prior art. Claim 22 was rejected under 35 U.S.C. §103(a) as being unpatentable over Rowlett. Claims 47 and 49-51 were rejected under 35 U.S.C. §103(a) as being unpatentable over either Shimizu, Rowlett, or Charhut. Claims 48 and 53 were rejected under 35 U.S.C. §103(a) as being unpatentable over Charhut in view of Merrill.

These rejections are respectfully traversed.

The Charhut patent discloses an automated prescription vial filling system. The system generally provides for dispensing of drugs, wherein a patient's order of one or more prescriptions can be automatically filled. Three or more filler lines are used to store various drugs, and a vial size is assigned to each line. When a prescription is filled, it is automatically assigned to one of

the lines based on the vial size requirements. The Charhut patent also provides an ability to collect all of a patient's prescriptions so that they may be consolidated into a single order. The Charhut patent, however, does not disclose features such as simultaneous counting and sequential dispensing of pills.

The Rowlett patent discloses a medication dispensing apparatus that is generally capable of dispensing a selected one of a plurality of drugs. A cabinet is used to house a plurality of individual dispensing mechanisms, each of which is adapted to store and dispense a plurality of a selected drug unit. A control unit is provided to generate a drug dispense signal corresponding to the selected drug and cause the appropriate dispensing mechanism to dispense the drug. The control unit can maintain an inventory of the stored drugs, and can be preprogrammed with a prescribed schedule for a particular patient such that a can be dispensed for the patient only during a certain time period. The Rowlett patent, however, does not disclose features such as simultaneous counting and sequential dispensing of pills.

The Shimizu patent generally discloses a drug dispensing apparatus that includes a drug dispensing unit and a control unit. The apparatus is capable of dispensing individual drug doses to a common collection area from one or more drug dispensing cartridges for packaging. The drug dispensing unit is internally provided with a plurality of shelves, with a plurality of drug dispensing cartridges removably disposed on each of the shelves. Each of the drug dispensing cartridges accommodates a plurality of individual identical drug doses. Each drug dosage is discharged one at a time from the cartridge through rotation of rotary members in compliance with input information received from the control unit. The Shimizu patent, however, does not disclose features such as simultaneous counting and sequential dispensing of pills.

Independent claim 16 of the present invention defines an automated prescription dispensing system that comprises:

a plurality of adjacently arranged pill dispensers, each operable to count out and dispense pills of a different pharmaceutical, computer control means for storing a plurality of prescriptions each specifying a different pharmaceutical in pill form and a number of pills and for selecting the pill dispensers dispensing the pharmaceuticals specified in said stored prescriptions and controlling the selected pill dispensers to simultaneously count out pills from said pill dispensers and sequentially dispense said counted pills, said computer control means stopping each pill dispenser from counting out and dispensing pills when the number of pills specified in the corresponding prescription have been counted out and dispensed, and label means to produce prescription container labels, said computer control means causing said label means to produce prescription labels containing information corresponding to said stored prescriptions, wherein said label means produces said prescription labels one at a time and will not produce a prescription label for the next prescription until after pills specified in a preceding prescription have been received from a pill dispenser into a prescription container.

One significant feature of independent claim 16 is the manner in which the pills are counted out and dispensed. More particularly, the pill dispensers are controlled such that they simultaneously count out the pills, but sequentially dispensed them. Consider, for example, five dispensers that will be counting out 100 pills each to be dispensed. For example, all five dispensers are initially controlled to simultaneously count out 100 pills. However, the pills from each dispenser are then sequentially dispensed. Referring to the previous example, assume that each dispenser requires 15 seconds to count 100 pills. Conventional devices would consequently require 75 seconds just for counting out the pills. According to the automated prescription dispensing system of claim 16, and one embodiment of the present invention, only 15 seconds are required to count out all the pills because the dispensers operate in parallel to simultaneously count out the pills. As can be seen, significant time savings can be realized through the use of the invention defined by independent claim 16. Advantageously, the present invention, in one

embodiment, only sequentially dispenses the pharmaceuticals to ensure, for example, the appropriate pharmaceutical is dispensed in the appropriate bottle.

The Office Action alleges that the applied references anticipate and render claim 16 obvious. In support of this rejection, the Office Action indicates, for example, that Charhut discloses a pill dispensing and packaging machine that comprises all the elements recited in independent claim 16. These elements include: a plurality of pill dispensers containing different pills, computer control means to store prescriptions to count out and dispense the pills into a package and to stop the dispensers when the desired number of pills are dispensed, and a labeling device that labels containers either during or immediately after the pills have been dispensed into the containers. Shimizu is indicated as disclosing all of the features of independent claim 16 except for the use of a printer as claimed. The prior art cited in the Information Disclosure Statements are also alleged as disclosing the features recited in independent claim 16. The Office Action also cites various passages in the references wherein it is believed the claimed features are disclosed.

Contrary to the assertions made in the Office Action, however, the applied references and the prior art cited in the IDSs do not anticipate or render independent claim 16 (or any of the pending claims) obvious. Review of the passages cited in the Office Action has not revealed any disclosure or suggestion for the specific combination of features recited in independent claim 16. For example, none of the cited references provide any disclosure or suggestion for an automated prescription dispensing system wherein pill dispensers are controlled to **“simultaneously count out pills from said pill dispensers and sequentially dispense pills,”** in combination with the remaining elements of claim 16. For example, column 3, lines 44-62 of Charhut (cited in the Office Action) does not reveal any information that the pills are simultaneously counted out, and

sequentially dispensed. Likewise, the passages cited from the remaining references do not reveal any disclosure or suggestion for such features in combination with the remaining claim elements. As described earlier, in one embodiment of the present invention, great savings in dispensing time and safety are achieved as a result. No such savings are at all described in the prior art.

Specifically, the prior art fails to disclose or suggest the combination of limitations, where:

a plurality of adjacently arranged pill dispensers, each operable to count out and dispense pills of a different pharmaceutical, computer control means for storing a plurality of prescriptions each specifying a different pharmaceutical in pill form and a number of pills and for selecting the pill dispensers dispensing the pharmaceuticals specified in said stored prescriptions and controlling the selected pill dispensers to simultaneously count out pills from said pill dispensers and sequentially dispense said counted pills, said computer control means stopping each pill dispenser from counting out and dispensing pills when the number of pills specified in the corresponding prescription have been counted out and dispensed, and label means to produce prescription container labels, said computer control means causing said label means to produce prescription labels containing information corresponding to said stored prescriptions, wherein said label means produces said prescription labels one at a time and will not produce a prescription label for the next prescription until after pills specified in a preceding prescription have been received from a pill dispenser into a prescription container.

It is therefore respectfully submitted that, as amended, independent claim 16 is allowable over the art of record.

Claims 17 and 18 depend from independent claim 16, and are therefore believed allowable for at least the reasons set forth above with respect to independent claim 16. In addition, claims 17 and 18 include additional limitations that are independently patentable. For example, claim 17 further recites “a plurality of output hoppers are provided, one for each of said pill dispensers to receive the pills counted out and dispensed by said pill dispensers, said computer control means including means to selectively permit the release of the pills from said output hoppers into prescription pill containers,” in combination with the features of independent

claim 16. The prior art does not provide disclosure or suggestion for such a combination of elements.

Independent claims 19 and 21 have been amended, somewhat similar to claim 16, to recite the additional features of simultaneously counting out the pills and sequentially dispensing them. As previously indicated with respect to independent claim 16, such features are not taught, shown, or in any way suggested by any of the applied references. Furthermore, the combination of features recited in claims 19 and 21 is not shown or suggested by any of the applied references.

It is therefore respectfully submitted that independent claims 19 and 21 are also allowable over the art of record.

Claim 22 depends from independent claim 21, and is therefore believed allowable for at least the reasons set forth above with respect to independent claim 21. In addition, claim 22 includes additional limitations that are independently patentable when considered in view of the combination of features recited in claim 21. More particularly, claim 22 further recites that “said means to increase said hopper quantity includes a bar code reader to read a bar code on a bulk supply container of pills to be added to the supply hopper of a given pill dispenser.” Such a combination of features is not shown or suggested by the prior art.

Newly presented independent claim 28 defines an operator assisted prescription dispensing system that comprises the following combination:

a plurality of pill dispensers, each operable to count out pills of at least one pharmaceutical, at least one computer controller including a control system responsively connected to and controlling said plurality of pill dispensers and storing a plurality of prescriptions each specifying a pharmaceutical in pill form and a number of pills, and for selecting said plurality of pill dispensers dispensing the pills specified in at least one of said plurality of prescriptions and controlling said plurality of pill dispensers to



simultaneously count out the pills, said computer controller stopping each pill dispenser from counting out the pills when the number of pills specified in the corresponding prescription have been counted out, said computer controller controlling said plurality of pill dispensers to sequentially dispense the counted pills corresponding to at least one of said plurality of prescriptions, and a label system to produce prescription container labels, said computer controller causing said label system to produce prescription labels containing information corresponding to said stored prescriptions, wherein said label system produces said prescription labels one at a time and will not produce a prescription label for the next prescription until after pills specified in a preceding prescription have been received from a pill dispenser into a prescription container.

Similar to independent claim 16, claim 28 also reflects the combination of features of simultaneously counting out the pills and sequentially dispensing them. Such features have previously been indicated as lacking in the art of record. In particular, the art of record does not provide disclosure or suggestion for these features in combination with the remaining elements of claim 28. Applicants have also indicated the benefits achieved by such features. Review of the passages cited by the Office Action has not revealed any disclosure or suggestion for the combination of features recited in independent claim 28. The applied references simply do not suggest a prescription dispensing system having the combination of features recited in claim 28.

It is therefore respectfully submitted that independent claim 28 is allowable over the art of record.

Independent claims 29-45 and 52-54 also define operator assisted prescription dispensing systems that include either (in some cases both) interaction with the operator or simultaneously counting out the pills, while sequentially dispensing the pills. As previously stated, these features, when viewed in combination with the remaining elements (or steps/features) of independent claims 29-45 and 52-54, are simply not shown or in any way suggested by any of the applied references, taken individually or in combination.

It is therefore respectfully submitted that independent claims 29-45 and 52-54 are allowable over the art of record.

Claims 46-51 depend from independent claims 28-45, and are therefore believed allowable for at least the reasons set forth above with respect to independent claims 28-45. In addition, these claims each introduce novel elements that independently render them patentable over the art of record. For example, claim 46 indicates that “each of said pill dispensers signals the operator to assist in dispensing the pills when ready.” This feature, in combination with the additional elements of claims 28-45, is not shown or suggested by the art of record.

Claim 47 further includes “a plurality of output hoppers one for each of said pill dispensers to receive the pills counted out by said pill dispensers, output snouts, one connected to each of said output hoppers, said controller controlling the selective release of the pills from said output hoppers through the corresponding output snouts, said output snouts being arranged in at least one row and defining an aisle extending adjacent to and parallel to said row to permit the operator to have ease of access to pills dispensed through said snouts,” in combination with the features of claims 28-45. Claim 51 further requires that “said controller indicates to the operator when a hopper quantity of at least one of said dispensers requires refilling responsive to predetermined criteria and increases the hopper quantity for the at least one dispenser when the pills are added to a supply hopper of the at least one dispenser by a number of pills,” in combination with the features of claims 28-45.

Claims 55-72 are newly presented and define article dispensing systems. In particular, the article dispensing systems defined by claims 58, 63-65, and 70 define operator assisted systems requiring interaction with an operator. Claims 55-72 include broader aspects of independent claim 20 that was allowed and issued without any comment by Applicants, and therefore, the broader aspects were not surrendered during prosecution of U.S. Patent 5,720,154,

and to which Applicants are entitled protection. Furthermore, the combination of features defined by claims 55-72 is not shown or suggested by the prior art.

It is therefore respectfully submitted that claims 55-72 are allowable over the art of record.

#### Response to Arguments

In response to Applicants' arguments, the Office Action indicates that each reference used to reject the claims shows an article dispensing means that comprises a plurality of dispensing units, each including a counter and a computer controller controlling the dispensing units and counters. The Office Action alleges that the references need not disclose the claimed function but merely set forth the structure because no patentable weight is afforded to functional language unless it is set forth in "means plus function" terms under 35 U.S.C. §112, sixth paragraph. The Office Action also identifies a new reference (U.S. Patent 5,101,359 to Gross) that allegedly discloses a system for automatic discharge of articles that can be operated in different modes, one of which is the simultaneous counting and sequential dispensing of articles.

Applicants respectfully disagree with these assertions. As discussed during the telephone conference of July 27, the mere fact that a claim does invoke 35 U.S.C. §112, sixth paragraph does not negate limitations on the claim scope through the use of functional language. For example, in *In re Ludtke* the Court of Customs and Patent Appeals (CCPA) has held that "... as we said recently *In re Swinehart*, ... there is nothing intrinsically wrong with the use of such claim language." 169 USPQ 563, 566 (C.C.P.A. 1971). Similarly, in *In re Land*, the C.C.P.A. held:

It is true that the italicized portions [in claim 70, i.e., "adapted to be rendered diffusible"] are "functional" but we do not regard that as good ground to give them "no weight" in view of the third paragraph of 35 U.S.C. 112. We give them weight and with this limitation we think claims 70 and 71 are limited to deferred diffusion built into the structure recited, thereby being limited to the

actual invention disclosed and hence allowable for the same reasons given by the board.

151 USPQ 621, 635-36 (C.C.P.A. 1966).

Applicants therefore respectfully submit that the functional limitations recited in the claims should be given weight when interpreting the claim as a whole.

Applicants further disagree with the Examiner's interpretation of the Gross reference. The Gross patent cannot operate in the claimed dispersing system because there is no mechanism to handle different product pharmaceuticals responsive to prescription orders. More particularly, the Gross system is quite elementary, and incapable of dispensing different products and/or pharmaceuticals.

#### Miscellaneous Papers

The Office Action also objects to the application under several grounds as lacking various papers. For example, the Office Action indicates that the application lacks a proper written consent of all assignees owning an undivided interest in the patent. The Reissue application is also indicated as being filed without a proper offer to surrender the original patent. A proper assent of the assignee is also indicated as lacking. The Office Action notes, however, that copies of these forms appear to be on file although they are not signed.

Applicants are including with this response, copies of the above-referenced documents as filed on October 27, 2000, together with the stamped postcard from the Patent Office. Withdrawal of these objections is therefore respectfully requested.

For the reasons stated above, it is respectfully submitted that the present reissue application and all of the pending claims are now in condition for allowance. The Examiner is

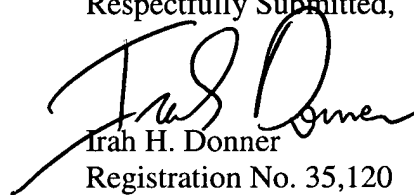
respectfully requested to contact the undersigned, if it is believed that such contact would further the examination of the present application.

**AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees that may be required for this Amendment, or credit any overpayment, to deposit account number 08-0219.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of which is required to make this response timely, and is hereby authorized to charge any fee for such, to deposit account number 08-0219.

Respectfully Submitted,

  
Ira H. Donner  
Registration No. 35,120

WILMER CUTLER PICKERING HALE AND DORR LLP

300 Park Avenue

New York, NY 10022

Telephone: 212.937.7246

Facsimile: 212.391.7300

Date: 9/20/04